

REMARKS/ARGUMENTS

These remarks are submitted responsive to the office action dated June 15, 2004 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

In paragraph 3 of the Office action, claim 1 was rejected under 35 U.S.C. § 112, second paragraph for being indefinite due to minor informalities. Claim 1 and 22 have been amended to correct these minor informalities. As a result of these amendments, a withdrawal of the 35 U.S.C. § 112 rejection to claim 1 is respectfully requested.

In paragraph 4, claims 1-4, 8-10, 12, and 22-32 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Published Application No. US 2001/0042083 to Saito, *et al.* (Saito). In paragraph 4, claim 13 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,286,043 to Cuomo, *et al.* (Cuomo). Applicants also note that Cuomo and the subject-matter of the claimed invention were, at the time the invention was made, both subject to an obligation of assignment to International Business Machines Corporation of Armonk, NY. As such, under 35 U.S.C. § 103(c), Cuomo is not a valid reference for purposes of 35 U.S.C. § 103 (which the Examiner has not asserted in the Office Action - Applicants merely point out the common assignee so as to bring a fact that could otherwise easily be overlooked to the Examiner's attention.)

In paragraph 5, claims 5 and 11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito in view of Applicant Admitted Prior Art (AAPA). In paragraph 5, claims 6 and 7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito in view of Published Application No. US 2002/0107881 to Patel (Patel). In paragraph 5, claims 14-19 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito in view of Published Application No. US 2002/0116421 to Fox (Fox). In paragraph 5, claim 20 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito in view Fox, in further view of AAPA.

In response to the Office Action, Applicants have amended claims 1 and 22 to clarify that each template is associated with a target markup language, as noted at page 18, lines 7-10 at page

20, liens 19-21, at page 23, lines 5-11, and throughout the specification. Claims 8-11 and 28-31 have been amended for grammatical reasons resulting from the amendments to claims 1 and 22.

Claim 13 has been amended in a similar fashion as claim 1 to indicate that templates are associated with both a document and a target markup language different from the markup language of the document. Support for this amendment is detailed above (the same as the support for amendments to claims 1 and 22).

Claim 14 has been amended in a fashion similar to claims 1, 13, and 22. Claims 17-21 have been amended for grammatical reasons resulting from the amendments to claim 14. No new matter has been added as a result of these amendments.

Applicants have enclosed affidavits under 37 C.F.R. § 1.131 supporting the removal of Fox and Patel as references. The affidavits are accompanied by a copy of the Applicants' Confidential Invention Disclosure No. BOC8-1999-0119 (Disclosure) entitled "Method and Apparatus Parse Generic HTML Data for Voice Presentation and User Interaction." The Disclosure and Affidavits demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as November 11, 1999, which predates the effective date of Fox of February 17, 2001 and the effective date of Patel of February 2, 2001.

The Disclosure is a completion of an IBM confidential disclosure form, which is a standardized document utilized by the International Business Machines Corporation (IBM) and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the Disclosure, once the Disclosure has been completed. Any changes and/or additions are appended to an attachment to the IBM confidential disclosure form along with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since November 11, 1999.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed invention when used in conjunction with information known by one of skill in the art. The present Application including each claim within the present Application has been prepared based upon the Disclosure.

Further, as noted in the enclosed Affidavits, prior to submission of the application to the United States Patent and Trademark Office (USPTO), the inventors reviewed the Application to insure that the claims and material contained therein were fully supported by the Disclosure.

Applicants further exercised due diligence from prior to the effective date of Fox and Patel until March 6, 2001, the filing date of the instant application. In regard to diligence, as set forth in the Affidavits, once an IBM invention disclosure form is completed, the Disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application, and instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the Application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the Application sufficiently details the inventive concepts detailed in the Disclosure, at which time the Application is expeditiously filed with the USPTO.

Since Applicants conceived of the present invention before the effective date of Fox and Patel and exercised due diligence in constructively reducing the invention to practice between the date of the Disclosure until the filing date, as supported by the enclosed affidavits, Fox and Patel should be withdrawn as a reference for purpose of 35 U.S.C. § 103(a), which action is respectfully requested. Withdrawal of Fox and Patel as a references should result in a withdrawal of the rejections with respect to claims 6, 7, and 14- 21.

Prior to addressing the rejections on the art, a brief review of the Applicants' invention is in order. Applicants disclose a system, method, and apparatus for automatically extracting data from a Web page for presentation in a targeted medium or interface. That is, content in a document formatted using a first markup language can be extracted for presentation within a second, newly created document, wherein the newly created document is formatted using a second, different markup language. Notably, the markup languages can differ in modality. For example, the first markup language can be directed to presentation of visual text; and, the second markup language can be directed to presentation of speech.

The information can be extracted from the first document for presentation in the second document using templates which correspond to the specific web pages. The templates can be stored in a data structure in memory to be retrieved upon a user requesting a web page for which a template exists. Thus, the invention can extract information only from documents for which corresponding templates exist. Each template can be designed for data presentation within a targeted medium or receiving interface.

Turning specifically to the rejections on the art, in paragraph 4, claims 1-4, 8-10, 12, and 22-32 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Saito. Saito discloses a method for extracting textual information from a image that includes text digitally encoded in a graphical format. Part of the text extraction process involves isolating regions of the image that contain the digitally encoded text from regions of the image that do not contain text. Saito teaches that an automatic routine is to segment an image into a plurality of regions, and that a user is to select and label one or more of these regions that contain text. Optical character recognition or other text extraction operations can be performed against the user selected region.

Saito also teaches that a template for text extraction called a "search template" can be generated based upon the user input and automatically determined set of characteristics for the selected search area. A plurality of search templates can be stored within a data store along with the associated image files from which the template was generated. When a new text extraction operation for a new document is performed, the new document is compared against the image files to determine if one or more of the image files are "substantially similar" to the new document, as noted at column 2, paragraph 36. When a substantially similar image is found, the stored search template associated with the similar image can be used to perform text extraction against the new document.

Referring to claim 1 and 22, Applicants claim the steps of:

identifying a template which corresponds to a specified document and a target markup language, said specified document including said formatted content that is formatted using a markup language;

applying said template to said specified document, an application extracting data from said formatted content; and

formatting said data based upon the template; wherein formatting produces a second document formatted for the target markup language.

Saito teaches templates are to be used to specify text regions for OCR text extraction. Saito does not teach that templates are to be associated with a target markup language so that a document formatted for that markup language can be generated from a source document written in a different markup language.

Because Saito fails to teach each claimed limitation, the 35 U.S.C. § 102(e) rejections to claims 1-4, 8-10, 12, and 22-32 should be withdrawn, which action is respectfully requested.

In paragraph 4, claim 13 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,286,043 to Cuomo, et al. (Cuomo). Cuomo teaches a technique for collecting information about user behavior in the presence of dynamic page content.

Referring to claim 13, Applicants claim:

determining at least one data location within at least one specified document containing formatted content;

constructing at least one template having one or more content markers which correspond to said data location, each said template corresponding to a specified document and a target markup language; and,

mapping said templates to said specified documents using a template table, wherein said templates are used to generate documents containing content from the associated specified document and formatted using an associated target markup language, even though the associated specified document is written in a different markup language than the target markup language.

Cuomo does not teach that templates are to be associated with a target markup language so that a document formatted for that markup language can be generated from a source document written in a different markup language.

Because Cuomo fails to teach each claimed limitation, the 35 U.S.C. § 102(e) rejections to claim 13 should be withdrawn, which action is respectfully requested.

In paragraph 5, claims 5 and 11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito in view of AAPA. AAPA however fails to cure the deficiencies of Saito.

More specifically, neither Saito, AAPA, nor any combination thereof teach or suggest that templates are to be associated with a target markup language so that a document formatted for that markup language can be generated from a source document written in a different markup language. Accordingly, the 35 U.S.C. § 103(a) rejections to claims 5 and 11 should be withdrawn, which action is respectfully requested.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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Gregory A. Nelson, Registration No. 30,577
Richard A. Hinson, Registration No. 47,652
Brian K. Buchheit, Registration No. 52,667
AKERMAN SENTERFITT
Customer No. 40987
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000